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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/819,459
Filing Date: March 28, 2001
Appellant(s): UENO ET AL.

Jianping Zhang (Reg. No. L414)
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed on May 2, 2008 appealing from the Office action mailed on December 3, 2007.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The statement of the status of Amendments contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of invention contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The summary of the ground of rejection to be reviewed on appeal contained in the brief is correct.

(7) Claim Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence relied Upon

US 6,877,661	Webb et al.	04-2005
US 60/225,805	Webb et al.	08-2000

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 8, 9, 11-18, 20, 21, and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Webb et al (hereinafter Webb), U.S. Patent No. 6,877,661.

Regarding to claim 1, Webb discloses a processing system comprising:

a data management server for storing registration information about a customer (figure 7 and column 10, lines 30-65, ***the data center 310***), *the registration information linked to a financial account of the customer with an external financial institution* (column 3, lines 13-15, Webb's invention is also used to *replace electronic transaction (payment) cards from a variety of industries*; column 10, lines 50-55, the data center web site *also allows the user to view and manage financial accounts*; column 16, lines 1-52, Webb's invention also used as a payment network for the purchased made at the store 324, *the data center 310 sends a barcode to the user's cellular phone 302 which represents a credit card payment transaction* to be used to purchase the selected goods; *when signing up to use the data center payment system, the user provides banking information* and authorizes the data center payment system to generate ACH

transactions on behalf of the user. Thus, *the data center 310 stores the user's credit card information and bank account information)*;

a customer communication terminal adapted for data communication with said data management server and for outputting information for identifying a customer (figure 7 and column 9, lines 55-65, ***the cellular phone 302***); and

a process execution terminal for receiving said information for identifying the customer from said customer communication terminal and executing a process for said customer (figure 7, ***Cash register 326***), wherein:

said process execution terminal provides said information to said data management server when receiving said information for identifying the customer (column 11, lines 55-65, the cash register 326 queries the data center 310 to determine whether or not a valid coupon relevant to the currently scanned list of goods exists for the identified user);

said data management server identifies the customer based on said information provided from said process execution terminal, generates reply information based on said registration information about said customer, and provides said reply information to said process execution terminal (column 12, lines 5-30, the data center 310 matches the list against all of the existing coupon in its database for the particular user and send a discount code bad to the cash register 326); *the reply information indicating an approval of payment from the financial account* (column 17, lines 23-37, the consumers makes a request to purchase goods, and this request is transmitted to the data center 310 for verification, after verification, the data center 310 then transmits a single use

ACH or credit card identifier back to the store, after acceptance, the single use string is sent back to the data center 310 where it can be converted into a true ACH or credit card transmission string to be cleared through traditional processes); and

said process execution terminal executes a process for said customer based on said reply information when receiving said reply information (column 12, lines 25-30, the cash register 326 identifies the discount code and updates the bill, and the user can then pay the bill to completer the transaction).

wherein the information for identifying the customer and the registration information about the customer is associated with each other only at the data management server, the data management server being different than the process execution terminal that receives the information for identifying the customer (figure 8 and column 17, line 40-column 18, line 50, the data center 310 includes is database servers store User Data and Coupon Data; the data center 310, different than the cash register 326).

Regarding to claim 2, Webb further discloses said data management server sends said information for identifying the customer to said customer communication terminal when said customer communication terminal accesses said data management server (column 14, lines 10-25, the data center 310 send the barcode coupon to the user's cellular phone 302); and said customer communication terminal receives said information sent from said data management server and outputs said information to said process execution terminal (column 14, lines 25-35, the user gives the cellular phone 302 with displayed barcode to the store clerk to be scanned at the cash register 326).

Regarding to claim 3, Webb further discloses wherein said data management server inquires to an external credit institution about a credit card number for payment and provides information obtained from said external credit institution as said reply information if said registration information is the number of a card for payment (column 16, lines 1-12).

Regarding to claim 4, Webb further discloses wherein said data management server information communicates an amount billed included in said registration information as said reply if said registration information is information about billing issued to said customer (column 16, lines 40-55).

Regarding to claim 5, Webb further disclose wherein: said data management server determines whether an admission ticket is valid or not and provides the determination as said reply information, if said registration information is information about said admission ticket, and said process execution terminal outputs information indicating whether said customer is granted admittance or not based on said reply information from said data management server (column 20, lines 15-27).

Regarding to claim 6, Webb discloses a processing system comprising:

a data management server for associating an identification code identifying a customer with registration information registered for said customer and sending mark data representing said identification code to a customer communication terminal (figure 7 and column 10, lines 30-65, ***the data center 310***; column 14, lines 10-25, the data center 310 send the barcode coupon to the user's cellular phone 302); and

a process execution terminal adapted for data communication with said data management server, said process execution terminal having a mark reader for reading a mark displayed on the display of said customer communication terminal based on said mark data, and executing a process for said customer based on said read mark data (figure 7, ***Cash register 326***; column 14, lines 25-35, the user gives the cellular phone 302 with displayed barcode to the store clerk to be scanned at the cash register 326), wherein:

said process execution terminal sends said mark data read by said mark reader to said data management server (column 11, lines 55-65, the cash register 326 queries the data center 310 to determine whether or not a valid coupon relevant to the currently scanned list of goods exists for the identified user);

said data management server identifies said registration information associated with said identification code based on said mark data sent from said process execution terminal, generates instruction information indicating a process to be performed for said customer based on said registration information, and sends said instruction information to said process execution terminal (column 12, lines 5-30, the data center 310 matches the list against all of the existing coupon in its database for the particular user and send a discount code back to the cash register 326), and

said process execution terminal, which receives said instruction information, executes the process for the customer based on said instruction information (column 12, lines 25-30, the cash register 326 identifies the discount code and updates the bill, and the user can then pay the bill to completer the transaction).

wherein the information for identifying the customer and the registration information about the customer is associated with each other only at the data management server (figure 8 and column 17, line 40-column 18, line 50, the data center 310 includes database servers store User Data and Coupon Data).

Regarding to claim 8, Webb further discloses wherein said mark data sent to said customer communication terminal from said data management server is invalidated after the completion of the process in said process execution terminal (column 12, lines 12-17).

Regarding to claim 9, Webb further discloses wherein said data management server sets information different from a payment card number held by said customer or an account number of said customer as said identification code (column 16, lines 13-30).

Regarding to claim 11, Webb discloses a server comprising:

data storage for associating an identification code identifying a customer with registration information registered for said customer and storing said identification code and said registration information (figure 7 and column 10, lines 30-65, ***the data center 310***; column 14, lines 10-25, the data center 310 send the barcode coupon to the user's cellular phone 302);

a customer communication section capable of data communication with a customer communication terminal (figure 7 and column 9, lines 55-65, ***the cellular phone 302***); and

a code issuing section for sending said identification code to said customer

communication terminal through said customer communication section in response to a received request (column 14, lines 10-25, the data center 310 send the barcode coupon to the user's cellular phone 302).

wherein the information for identifying the customer and the registration information about the customer is associated with each other only at the data management server (figure 8 and column 17, line 40-column 18, line 50, the data center 310 includes is database servers store User Data and Coupon Data).

Regarding to claim 12, Webb further discloses wherein said code issuing section sends said identification code in barcode data form (column 10, lines 25-30).

Regarding to claim 13, Webb further discloses wherein said data storage associates a password set by said customer with said identification code and stores said password and said identification code; and said code issuing section verifies whether a password, input from said customer communication terminal, matches said password stored in said data storage, and issues said identification code (column 16, lines 5-12).

Regarding to claim 14, Webb further discloses further comprising: a process executer communication section capable of data communication with a process execution terminal for execution of a process requested by said customer; and all instruction information issuing section for generating instruction information indicating the process to be performed by said process execution terminal for said customer based on said registration information associated with said identification code when receiving said identification code issued by said code issuing section through said

process executer communication section from said process execution terminal, and providing said instruction information to said process execution terminal through said process executer communication section (column 12, lines 30-65).

Regarding to claim 15, Webb further discloses wherein said data storage stores as said registration information a number of membership points held by said customer; said instruction information issuing section informs a process execution terminal of the number of membership points as said instruction information when receiving said identification code and stores a new number of membership points in said data storage when receiving a new number of membership points changed from said number of membership points from said process execution terminal (column 19, lines 40-55 and column 23, lines 8-10; membership program, membership card).

Regarding to claim 16, Webb further discloses a process confirmation section for confirming whether a process requested by said process execution terminal should be performed or not with said customer communication terminal before said instruction information issuing section provides said instruction information to said process execution terminal (column 12, lines 5-30).

Regarding to claim 17, Webb discloses a processing terminal comprising:

a code receiver for receiving an identification code, output from a communications terminal of a customer, for identifying said customer (column 11, lines 35-37, the barcode displayed on the customer's phone is scanned at the ash register); and

process information output logic for inquiring of all external server about said identification code received by said code receiver and outputting process information for

said customer based on a reply from said external server about said identification code (column 11, lines 55-65, the cash register computer queries the data center to determine whether or not a valid coupon relevant to the currently scanned list of goods exists for the identified user).

wherein the information for identifying the customer and the registration information about the customer is associated with each other only at the data management server (figure 8 and column 17, line 40-column 18, line 50, the data center 310 includes is database servers store User Data and Coupon Data).

Regarding to claim 18, Webb further discloses wherein said code receiver receives said identification code data from said customer communications terminal by communication wireless (column 11, lines 37-55).

Regarding to claim 20, Webb further discloses wherein said process information output logic displays an amount claimed from said customer based on a reply provided by said external server about said identification code (column 12, lines 18-30).

Regarding to claim 21, Webb discloses a communication terminal comprising:

a display for displaying an image (figure 7 and column 9, lines 55-65, ***the cellular phone 302***; column 11, lines 13-15, a barcode is displayed on the phone's LCD display).

a communicator capable of accessing an external server (figure 7, Retailer's IT 322 infrastructure is capable of accessing Data Center 310);

a code issue requester for accessing an external server through said communicator and requesting said external server to issue a process code (column 11,

lines 24-37, the data center 310 send an initial barcode to the user wireless device 302); and

a display controller for causing said display to display said process code, wherein said process code is issued from said external sever and received through said communicator (column 11, lines 13-15, a barcode is displayed on the phone's LCD display);

wherein the external server issues the process code by associating information for identifying a customer using the communication terminal with registration information about the customer and wherein the information for identifying the customer and the registration information about the customer is associated with each other only at the data external server (figure 8 and column 17, line 40-column 18, line 50, the data center 310 includes is database servers store User Data and Coupon Data).

Claims 24-26 contain similar limitations found in claims 1, 11, 17 above, therefore, are rejected by the same rationale.

Claims 27-28 contain similar limitations found in claims 1,17 above, therefore, are rejected by the same rationale.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 7, 10, 19, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb et al (hereinafter Webb), U.S. Patent No. 6,877,661.

Regarding to claim 7, Webb does not disclose wherein said mark is a two-dimensional barcode. However, Webb discloses wherein said mark is a one-dimensional barcode (figure 1). Moreover, a two-dimensional barcode is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Webb to incorporate the well-known feature above for the purpose of providing the ability to scan the coupon with different type of barcode, e.g. two-dimensional barcode.

Regarding to claim 10, Webb does not disclose wherein said data management server sets a telephone number of said customer communication terminal as said identification code. However, setting a telephone number of said customer communication terminal, as said identification code is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Webb to adopt the well-known feature above for the purpose of providing more convenient in processing purchase transaction using customer communication terminal.

Regarding to claim 19, Webb further discloses wherein said code receiver comprises a barcode reader for reading a displayed on the display of said customer communications terminal (column 11, lines 35-37, the barcode displayed on the customer's phone is scanned at the cash register). Webb does not disclose reading a

two-dimensional barcode. However, reading a two-dimensional barcode is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Webb to incorporate the well-known feature above for the purpose of providing the ability to scan the coupon with different type of barcode, e.g. two-dimensional barcode.

Regarding to claims 22-23, Webb further discloses wherein said barcode displayed on said display is associated with information on billing issued to a customer holding said communications terminal (column 16, lines 5-12) and wherein said barcode displayed on said display includes data for an admission ticket (column 20, lines 15-27). Webb does not disclose displaying two-dimension barcode. However, displaying two-dimensional barcode is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Webb to incorporate the well-known feature above for the purpose of providing the ability to scan the coupon with different type of barcode, e.g. two-dimensional barcode.

(10) Response to Argument

In response to the appellants' arguments that Webb's provisional application does not disclose "*the registration information is linked to a financial account of the customer with an external financial institution*", examiner submits that Webb's provisional application discloses in page 13, section 4 (Affinity programs) that "*…signal from phone to register is equivalent to affinity program identification number such as grocery store frequent shopper card. This requires that the user be registered with the data center in a manner that links his/her affinity*

identification number with their coupon storage account", i.e., the user registers with the data center frequent shopper card (account) of the user with a grocery store (external financial institution). Also in section 5 (Other membership programs) that "*…the wireless handheld device is able to signal a transaction that recognizes the user of the cell phone as a member of a particular establishment (*linked to an external financial institution). *For example, heath clubs often use bar codes on membership cards to give quick entry to members arriving at the club.*" Therefore, *Webb's provisional application does disclose "the registration information is linked to a financial account of the customer with an external financial institution."*

(11) Related Proceedings Appendix

The statement of the related proceedings appendix contained in the brief is correct.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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